

### **REMARKS**

This responds to the Office Action mailed on November 17, 2006. No claims are amended or cancelled. Claims 1, 2, 4-24, 26-30, and 32 remain pending in this application.

#### **§103 Rejection of the Claims**

Claims 1, 2, 4-14, 16-18, 20-27, 29-30, and 32 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Taylor (U.S. Pat. No. 5950,629) in view of Rapoport (U.S. Pat. No. 5,957,934). Applicant respectfully submits that the claims are distinguishable over Taylor and Rapoport for at least the following reasons.

The rejection states that Taylor discloses “a guide unit having a linear range of motion” citing manipulator 14 with linear motion section 68 from Taylor. The rejection further states that Taylor discloses “a thumb wheel and/or rotating wheel advancer” again citing manipulator 14. The rejection further states that Taylor does not disclose a cable mechanism. However, Rapoport discloses shaft 30 and shaft 33 (read as cables in the rejection). The rejection states that one of ordinary skill in the art would be motivated to combine Rapoport with Taylor “to enhance accessibility to the surgical site as taught by Rapoport at col. 7, line 53.”

First, Applicant respectfully submits that neither Taylor nor Rapoport show all elements of pending independent claims 1, 13, 17, and 30. For example Applicant is unable to find in either reference an *MR compatible* cable. Procedures in both Taylor and Rapoport appear to be performed after an preoperative MR scan, while actual surgical motion of an instrument does not appear to include an MR compatible cable.

Second, Applicant respectfully submits that one of ordinary skill in the art would not be motivated to combine Taylor with Rapoport. Column 7, line 53 as cited in the present rejection recites a motivation only to remove the “receiver R and/or light source 95.” This motivation is not cited as a reason to employ the use of shaft 30 or shaft 33.

Third, Taylor teaches away from using robotic or motor driven motion control. Column 1, lines 48-51 states that a “problem associated with a robotic device is undesired motion.” Robotic motion is further discouraged in column 2, lines 7-20 of Taylor. In contrast, Rapoport shows motors 31 and 34 that robotically drive shafts 31 and 33. Applicant respectfully submits

that Taylor and Rapoport cannot be combined under 35 U.S.C. § 103(a) due to their opposed views on the best method to control motion during a procedure.

Because the cited references, either alone or in combination, do not show every element of Applicant's independent claims, a 35 USC §103(a) rejection is not supported by the references. At least the element of an MR compatible cable is not found in the references. Further, because the references teach away from a combination, a 35 USC §103(a) rejection cannot be maintained. Reconsideration and withdrawal of the rejection are respectfully requested with respect to independent claims 1, 13, 17, 24, and 30. Applicant respectfully submits that claims 2, 4-12, 14, 16, 18, 20-23, 25-27, 29, and 32 are in condition for allowance at least as depending from allowable base claims.

Claims 15, 19, and 28 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Taylor in view of Rapoport, and further in view of Stark (US. Pat. No. 5,823,975). Applicant respectfully submits that the additional reference of Stark fail to cure the rejection based on Taylor and Rapoport for at least the reasons outlined above.

Because the cited references, either alone or in combination, do not show every element of Applicant's independent claims, a 35 USC §103(a) rejection is not supported by the references. Reconsideration and withdrawal of the rejection are respectfully requested with respect to claims 15, 19, and 28.

### **CONCLUSION**

Applicant respectfully submits that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney at (612) 373-6944 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

### **Reservation of Rights**

In the interest of clarity and brevity, Applicant may not have addressed every assertion made in the Office Action. Applicant's silence regarding any such assertion does not constitute

any admission or acquiescence. Applicant reserves all rights not exercised in connection with this response, such as the right to challenge or rebut any tacit or explicit characterization of any reference or of any of the present claims, the right to challenge or rebut any asserted factual or legal basis of any of the rejections, the right to swear behind any cited reference such as provided under 37 C.F.R. § 1.131 or otherwise, or the right to assert co-ownership of any cited reference. Applicant does not admit that any of the cited references or any other references of record are relevant to the present claims, or that they constitute prior art. To the extent that any rejection or assertion is based upon the Examiner's personal knowledge, rather than any objective evidence of record as manifested by a cited prior art reference, Applicant timely objects to such reliance on Official Notice, and reserves all rights to request that the Examiner provide a reference or affidavit in support of such assertion, as required by MPEP § 2144.03. Applicant reserves all rights to pursue any cancelled claims in a subsequent patent application claiming the benefit of priority of the present patent application, and to request rejoinder of any withdrawn claim, as required by MPEP § 821.04.

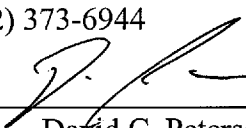
Respectfully submitted,

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By their Representatives,

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Date 2-20-07

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**CERTIFICATE UNDER 37 CFR 1.8:** The undersigned hereby certifies that this correspondence is being filed using the USPTO's electronic filing system EFS-Web, and is addressed to: Mail Stop Amendment, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 20<sup>th</sup> day of February 2007.

PATRICIA A. HULTMAN

Name

  
Signature